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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,776	07/25/2005	Masanori Itoh	OKUDP0104US	7313

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EXAMINER
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MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
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2165

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/519,776

Applicant(s)

ITOH ET AL.

Examiner

DIANE D. MIZRAHI

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DIANE MIZRAHI  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

*Claims 1-18 are pending in the present application. In light of Applicant's newly submitted remarks, Examiner issues a new non-final office action. Examiner has not withdrawn the obviousness-type double patenting. All previous presented rejections of the claims are hereby withdrawn as to being moot. See new office action below.*

**Claim Rejections - 35 USC 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02 and Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). The decisions state to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. A claim limited to a machine or manufacture, which has a practical application, is statutory. Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). That is, it must produce a "useful, concrete and tangible result". The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); In re Fisher, 421 F.3d 1365, 76 USPQ 2d 1255

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(Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ 2d 1600, 1603-06(Fed. Cir.1993).

Examiner recommends that to satisfy the 101 rejection, that the claims must produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77.

Regarding Claims 1 and 13, Applicant' recites conditional limitations for producing results, such as the claimed, "if a portion of audio data, .. is missing from the predetermined data unit..." such that the condition is not met, the claims will generate no useful, concrete, and tangible results. The result of the claimed, "copying" is conditional and will take place only the claimed, "if a portion of audio data, .. is missing from the predetermined data unit..." is met. There appears to be no transforming or production of any useful, concrete, and tangible results. Examiner recommends Applicant to amend the claims without adding any new matter to the originally filed specification.

Claims 2-12 and 14-18 are dependent claims and rejected under the same reasons as claims 1 and 13.

Examiner recommends that to satisfy the 101 rejection, and to be "useful", the claim must satisfy the utility requirement thus the invention has to be specific, substantial and credible. (MPEP 2107 and In re Fisher, 421 F.3d 1365, 76 USPQ 2d 1255 (Fed. Cir. 2005); the claims must produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77; and that the result that can be substantially repeatable or must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000).

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by David Locket et al. (US Publication No. 20020037160 A1 and Locket hereinafter).

Regarding Claim 1, Locket teaches a data processor comprising: a signal input section to which a video signal and an audio signal are input [0016][0041][0055][0067]; a compressing section for coding and compressing the video and audio signals to generate video data and audio data [0008][0065][0085][0056][0049]; a stream assembling section, [0047][0011][0012] which divides each of the video data and the audio data into a plurality of packets, and makes a plurality of data units, in each of which a video packet representing a fraction of the video data and an audio packet representing a fraction of the audio data are multiplexed together to generate a data stream composed of a plurality of said data units [0041][0055][0135]; and a writing section for writing the data stream on a storage medium [0045][0013][0050], wherein the stream assembling section determines, [0047][0011][0012] at least by a video playback time[0006][0007][0045], what video packets and audio packets are included in each said data unit, and if a portion of audio data, which is associated with the video data stored in a predetermined data unit,[0016][0096][0127][0131] is missing from the predetermined data unit,

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then copied data, [0053][0138]obtained by copying (i.e. reads on duplicating) [0138]partial audio data including at least that missing portion of the audio data, is put into the data stream [0048][0049][0056][0085][0061].

Regarding Claim 6, Locket teaches wherein the stream assembling section puts copied data, obtained by copying (i.e. reads on duplicating) [0138] all of the audio data synchronized with the video data, into the predetermined data unit.[0045][0066][0075][0082].

Regarding Claim 12, Locket teaches wherein the audio data has a data length corresponding to a first rate, and wherein the compressing section compresses and codes the audio signal at a second rate, which is lower than the first rate, and puts the compressed audio signal into the audio data, and wherein the stream assembling section stores the copied (i.e. reads on duplicating) [0138] data in a reserved area that represents a difference between a second data length, which is defined so as to correspond to the second rate, and the first data length of the audio data, which is defined so as to correspond to the first rate[0054][0062][0095][0135].

Regarding Claims 2-5, 7-11 and 13-18 these claims are similar in scope to the rejected claims above and are therefore rejected as set forth above.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-43 of copending Application No.

10/479692 . Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations, using varying terminology. This is a provisional obviousness-type double patenting rejection.

Claims 1-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No.

10/535,988 . Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations, using varying terminology. This is a provisional obviousness-type double patenting rejection.

#### **Other Prior Art Made of Record**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site

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([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



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March 10, 2007